

REMARKS**Election**

The Examiner indicated that the application contains patentably distinct species A-D. The Examiner indicated that applicant is required under 35 U.S.C. §121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held allowable. The Examiner indicated that Claims 1 and 26 are generic.

Telephone Conference with Examiner on November 1, 2005

In a telephone conference on November 1, 2005, the Examiner provided claim designations for species A -D.

- A. Species A: Claims 1, 2, 3, 8, 22, 23, 24, 25, 26, 27, 28, 29, 30, 32, and 35.
- B. Species B: Claims 1, 2, 4, 8, 23, 24, 25, 26, 27, 28, 29, 31, and 35.
- C. Species C: Claims 1, 2, 5, 8, 23, 24, 25, 26, 27, 28, 29, and 35.
- D. Species D: Claims 1, 6, 7, 8, 23, 24, 25, 26, 27, 28, 29, 33, 34, and 35.

Although a provisional election will be made as indicated below, this restriction requirement is respectfully traversed. As discussed in MPEP §806.04(f), claims that are restricted to different species must be mutually exclusive. MPEP §806.04(f) states "the general test as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first" (emphasis added).

The species identified in Species A-D are clearly not mutually exclusive. For example, all independent Claims (and consequently, all Claims) recite a feature that could be said to relate to testing a semiconductor tool using a wafer. With regard to identified species A-C, all

claims in species A-C recite a feature that could be said to relate to providing a film over a wafer and testing at least one characteristic of the film.

Accordingly, it cannot be said that the "one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first". Accordingly, the test under MPEP §806.04(f) is not satisfied and the Species A-D cannot properly be restricted.

In so far as the Examiner maintains the restriction requirement (which, as discussed above, is improper), Applicant provisionally elect Species D (namely, Claims 1, 6, 7, 8, 23, 24, 25, 26, 27, 28, 29, 33, 34, and 35).


If the Examiner has any questions concerning this application, please call the applicant's attorney Glen Chol at (212) 661-5488.

If there are any charges due, please charge our Deposit Account No. 02-2666.

Respectfully submitted,

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